Supreme Court, U.S.
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IN THE

# Supreme Court of the United States

BRASSICA PROTECTION PRODUCTS LLC
AND JOHNS HOPKINS UNIVERSITY,
*Petitioners,*

v.

SUNRISE FARMS, BECKY CRIKELAIR, FRANK CRIKELAIR,
EDRICH FARMS, INC., EDWARD B. STANFIELD, III,
EDWARD F. STANFIELD, JR., RICHARD STANFIELD,
SALLY F. STANFIELD, BANNER MOUNTAIN SPROUTS,
BANNER MOUNTAIN SPROUTS INC., LAWRENCE RAVITZ,
HARMONY FARMS, GREG LYNN, LORNA LYNN,
INTERNATIONAL SPECIALTY SUPPLY AND ROBERT L. RUST,
*Respondents.*

**On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit**

## PETITION FOR A WRIT OF CERTIORARI

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85 pp

## QUESTIONS PRESENTED

(1) Whether the Court of Appeals for the Federal Circuit erred when, in a patent litigation context, it gave no deference to the United States Patent and Trademark Office's determination of patentability and findings in reaching such determination?

(2) Whether the Court of Appeals for the Federal Circuit erred in granting summary judgment of patent invalidity, when the grant was on grounds for which the PTO had made explicit findings to the contrary, and when the movant failed to present any evidence of an essential element of its affirmative defense?

## PARTIES

The parties to the proceeding in the court of appeals, whose judgment is sought to be reviewed, are the same as in the caption.

There is no parent corporation or publicly held company that owns 10% or more of the stock of Petitioners Brassica Protection Products LLC or Johns Hopkins University.

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Petitioners Johns Hopkins University ("Johns Hopkins") and Brassica Protection Products LLC ("Brassica") respectfully pray that this Court grant a writ of certiorari to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit ("Federal Circuit") entered on August 21, 2002.

## OPINIONS BELOW

The August 21, 2002 opinion of the court of appeals, which is reported at 301 F.3d 1343 (Fed. Cir. 2002), is set out at pp. 1a-15a of the Appendix to this petition. The August 8, 2001 memorandum opinion of the district court, which is reported at 168 F. Supp. 2d 534 (D. Md. 2001), is set out at pp. 16a-26a of the Appendix. The August 8, 2001 order of the district court, which is also reported at 168 F. Supp. 2d 534 (D. Md. 2001), is set out at p. 27a of the Appendix. The September 30, 2002 order of the court of appeals, which is unreported, is set out at pp. 28a-29a of the Appendix. The August 14, 1997, January 27, 1999, March 1, 1999, and July 12, 2000 United States Patent and Trademark Office decisions are set out at pp. 30a-37a of the Appendix.

## JURISDICTION

The decision of the court of appeals was entered on August 21, 2002. *See* App. A, at p. 1a. The court of appeals denied Petitioner's request for rehearing on September 30, 2002. *See* App. D, at pp. 28a-29a. The jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254.

## STATUTES INVOLVED

Section 706 of the Administrative Procedure Act, 5 U.S.C. § 706, states in pertinent part:

> To the extent necessary to decision and when presented, the reviewing court shall decide all relevant

questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall—

(1) compel agency action unlawfully withheld or unreasonably delayed; and

(2) hold unlawful and set aside agency action, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(B) contrary to constitutional right, power, privilege, or immunity;

(C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right;

(D) without observance of procedure required by law;

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or

(F) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court.

In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.

Section 1 of the Patent Act of 1952, 35 U.S.C. § 102(b), states in pertinent part:

A person shall be entitled to a patent unless—

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the

United States...."

Section 1 of the Patent Act of 1952, 35 U.S.C. § 282, states in pertinent part:

> A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid though dependent upon an invalid claim.... The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity....

Rule 56(c) of the Federal Rules of Civil Procedure states in pertinent part:

> The [summary] judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.

## STATEMENT OF THE CASE

### Background of the Inventions

This case relates to significant discoveries in human cancer prevention that the United States Patent and Trademark Office ("PTO") deemed worthy of patent protection. In 1998 and 1999, the PTO granted three patents relating to these discoveries.[1] Dr. Paul Talalay and his colleagues at the Johns Hopkins University School of Medicine discovered that certain cruciferous vegetables[2] contain chemical com-

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[1] U.S. Patent Nos. 5,725,895 (issued Mar. 10, 1998), 5,968,505 (issued Oct. 19, 1999); 5,968,567 (issued Oct. 19, 1999).

[2] Cruciferous vegetable varieties include broccoli (*Brassica oleracea*

*footnote continued on next page*

pounds that induce the body to make enzymes that neutralize cancer-causing chemicals. They isolated these compounds, called "Phase 2 enzyme-inducers," and found them to prevent cancer in laboratory animals. Dr. Talalay and his research associate, Jed Fahey, developed a quantitative assay for measuring Phase 2 enzyme inducers, and discovered that at the sprout stage[3], some cultivars[4] contained between 10 and 100 times higher concentrations of inducers than at the mature plant stage, as well as lower concentrations of certain cancer-causing compounds. They further discovered that among different cruciferous sprout cultivars, concentrations of Phase 2 enzyme inducers varied from very low to very high. Based on these findings, the scientists determined that making and consuming food products from cruciferous sprouts containing high concentrations (*i.e.*, at least 200,000 units per gram fresh weight sprouts) of Phase 2 enzyme inducers would be an effective way to prevent cancer in humans.

Johns Hopkins' work was met with widespread acclaim. It was published in a prestigious scientific journal, Proceedings of the National Academy of Sciences USA, cited in more than 100 peer-reviewed journal articles, and featured in numerous television, magazine, and newspaper reports.

**The Patent and Trademark Office's Decisions**

All three patents granted by the PTO are directed to methods for making food products from sprouts that have high concentrations, or at least 200,000 units per gram fresh

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*italica*), cauliflower (*Brassica oleracea botrytis*), and kale (*Brassica olearcea acephala*).

[3] The patents define a sprout as "harvested following seed germination through and including the 2-leaf stage."

[4] For each cruciferous vegetable variety there are numerous, sometimes several hundred, genetically distinct subgroups known as "cultivars." For example, "Saga" is a popular cultivar of the broccoli variety.

weight sprouts, of Phase 2 enzyme inducers.[5] In determining whether to grant these patents, the PTO specifically considered the issue raised in the case below—whether the claimed inventions were described in prior printed publications.

Section 102(b) of the patent statute, 35 U.S.C., states that a patent may not be granted for an invention if it was described in a printed publication more than one year prior to the date on which the application for the patent was filed. Under section 102(b), a patent claim is "anticipated" by a prior printed publication if the publication describes all the elements of the invention, as defined by that patent claim. Every element of a patent claim is material because the patent claims define the scope of a patented invention. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997); *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372-73 (1996); *Schumacher v. Cornell*, 96 U.S. 549, 554 (1877); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339 (1961) ("[T]he claims made in the patent are the sole measure of the grant."); *Altoona Publix Theatres, Inc. v. American Tri-ergon Corp.*, 294 U.S. 477, 487 (1935) ("[I]t is the claims of the patent which define the invention.").

When comparing the description of the prior publication to the patent claims, it has been the law for over 100 years that:

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[5] The patent claims at issue recite methods for preparing food products comprising sprouts that are "rich in glucosinolates" or that contain "high Phase 2 enzyme-inducing potential". *See* Apps. I-K, at pp. 38a-41a. Glucosinolates are compounds that indirectly induce the production of Phase 2 enzymes and, therefore, have a Phase 2 enzyme-inducing potential. For simplicity of discussion, all compounds with a Phase 2 enzyme inducing potential are herein referred to as "Phase 2 enzyme inducers." Some claims require the concentration of glucosinolates or Phase 2 enzyme inducers to be at least 200,000 units per gram fresh weight sprouts. *Id.*

> Unless the earlier printed and published description [ ] exhibit[s] the later patented invention in such full and intelligible manner as to enable persons skilled in the art to which the invention is related to comprehend it without assistance from the patent, or to make it, or repeat the process claimed, it is insufficient to invalidate the patent.

*Cohn v. U.S. Corset Co.*, 93 U.S. 366, 370 (1876), *quoted in The Driven-Well Cases*, 122 U.S. 40, 66 (1887).

It is also well-settled that even when a prior publication is silent about one or more elements of the claimed invention, it may nevertheless anticipate the patent claim if the missing elements are "inherent" in the subject matter described in the publication. *General Elec. Co. v. Jewel Incandescent Lamp Co.*, 326 U.S. 242, 247 (1945). The Federal Circuit has elaborated on this general rule by stating that inherency may be proved by extrinsic evidence demonstrating that the missing element is "necessarily" (*i.e.*, always) present in the subject matter described in the publication. *MEHL/Biophil Int'l Corp. v. Milgraum*, 192 F.3d 1362 (Fed. Cir. 1999); *Glaxo, Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047-48 (Fed. Cir. 1995); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-69 (Fed. Cir. 1991); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985). Thus, evidence establishing only a possibility or probability that the missing element was present in the thing described does not establish inherency. *Continental Can*, 948 F.2d at 1269.

In its initial determination of patentability, the PTO found that the methods claimed in the patent applications were not described in prior printed publications, including publications that generally describe eating cruciferous vegetable sprouts. The PTO also found no evidence of prior public use in this country, and therefore determined that the claimed inventions overcame section 102(b)'s hurdle. *See* App. E-G, at pp. 30a-35a.

In 2000, the PTO reconfirmed the patentability of one of these patents in a reexamination proceeding[6] during which it considered additional prior publications that generally describe eating vegetable sprouts, including cruciferous sprouts. The PTO found that although the publications generally describe eating vegetable sprouts, they do not mention the critical claim limitation, *i.e.*, Phase 2 enzyme inducers, and do not describe eating any particular cultivars of cruciferous sprouts that contain Phase 2 enzyme inducers, either at high or low levels. *See* App. H, at p. 37a.

During the PTO's reexamination proceeding, Johns Hopkins submitted a sworn declaration by Jed Fahey on this issue. Mr. Fahey's declaration described the wide variation in Phase 2 enzyme inducer concentrations among various cruciferous cultivars. For example, the declaration stated that inducer potential ranged from 10,000 to 769,000 units in broccoli cultivars, from 50,000 to 560,000 units in cauliflower cultivars, and from 10,000 to more than 200,000 units in kale cultivars. *See* App. L, ¶¶ 7-10, at pp. 44a-45a. As a result, the PTO determined that "a method of preparing a food product wherein cruciferous sprouts, with the exception of cabbage, cress, mustard, and radish sprouts, that are rich in glucosinolates or contain high concentrations of Phase 2 inducer activity are harvested prior to the 2-leaf stage is not taught nor fairly suggested by the prior art or any combination thereof." *See* App. H, at p. 37a.

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[6] Before initiating the present litigation, Petitioners sued another company for infringement of the '895 patent in 1999. That case was settled. During the course of that litigation, the defendants filed a request for reexamination with the PTO. Reexamination is a procedure by which the PTO reexamines an issued patent based on prior art patents and/or printed publications that it did not previously consider. 35 U.S.C. § 302.

## Judicial Review of the Patent and Trademark Office's Decision

After the widespread publication of Johns Hopkins' discoveries, Respondents began copying the university's patented inventions, making and selling sprouts of the cultivars that Johns Hopkins had identified as having high concentrations of Phase 2 enzyme inducers. In 2000 Johns Hopkins and its exclusive patent licensee, Brassica, sued Respondents for patent infringement in several federal district courts. The actions were consolidated by the Judicial Panel for Multidistrict Litigation to be heard in the District of Maryland.

Respondents moved for summary judgment on the affirmative defense that the patents were invalid under 35 U.S.C. § 102(b). Respondents argued that the inventions were described in prior printed publications more than one year prior to the date of the application. In support of their summary judgment motion, Respondents submitted 12 publications, most of which the PTO had considered and found not to anticipate the patent claims. The publications offered by Respondents contain essentially the same subject matter as the references previously before the PTO, *i.e.*, growing and eating cruciferous sprouts, and like the previous references, do not mention Phase 2 enzyme inducers. Respondents never presented any evidence that any of the sprouts described in those publications contain Phase 2 enzyme inducers at high concentrations, or at least 200,000 units per gram fresh weight sprouts, or at any particular concentration whatever. Their publications never even described Phase 2 enzyme inducers or anything related to this concept.

Because Respondents failed to present any evidence that all of the elements of the patent claims were expressly or inherently described in the prior publications, Johns Hopkins and Brassica filed a cross-motion for summary judgment, submitting Mr. Fahey's sworn declaration that demonstrates that high concentrations, or at least 200,000 units per gram

fresh weight sprouts, of Phase 2 enzyme inducers are not an inherent property of all cruciferous sprouts.

The district court granted summary judgment in favor of Respondents, incorrectly stating that the concentrations of Phase 2 inducers recited in the claims were not elements of Petitioners' patent claims. App. B, at p. 25a. Petitioners thereafter appealed to the Federal Circuit.

Unlike the district court, the Federal Circuit recognized that the concentrations of Phase 2 inducers were indeed elements of the patent claims, App. A, at p. 7a, but affirmed the district court's summary judgment. Despite the fact that Respondents did not even argue that the patents were invalid due to prior public use[7], the Federal Circuit stated:

> Brassica cannot *credibly* maintain that no one has heretofore grown and eaten one of the many suitable cultivars identified by its patents.

*Id.* at p. 14a (emphasis added). This petition followed.

## REASONS FOR GRANTING THE WRIT

### I. Summary of Argument

In the case below, the Federal Circuit affirmed summary judgment to Respondents declaring invalid patents that had been duly issued by the PTO without any deference to the PTO's determinations, despite the fact that Respondents failed to provide any new evidence that could establish an essential element of their invalidity defense. In so doing, the Federal Circuit made factual and credibility determinations against the nonmovant.

This case presents important questions regarding whether,

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[7] As explained below, prior "public use" and prior "printed publication" are entirely separate and independent grounds for patent invalidity. Respondents never asserted a prior public use defense in this litigation.

and the degree to which, the Federal Circuit, in deciding patent cases, must follow traditional and well-settled rules of jurisprudence as articulated by this Court.[8] As will be explained and is manifest from the opinion below, there has been a clear tendency in the Federal Circuit's patent cases to disregard standards established through this Court's long-standing precedents regarding (1) judicial deference to agency decisions and (2) application of the Federal Rules of Civil Procedure relating to summary judgments. In doing so, the Federal Circuit has appeared to perceive of its role not so much as an appellate court but more of a *de novo* trier of fact and weigher of evidence—even with regard to facts in the summary judgment context.

The Federal Circuit's failure to apply traditional jurisprudence regarding the role of appellate courts vis-à-vis federal agencies and civil procedure is not infrequent. This Court corrected the Federal Circuit's failure to follow Rule 52(a) of the Federal Rules of Civil Procedure in substituting its view of facts for that of the district court in *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809 (1986). The Federal Circuit has

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[8] The patent laws promote scientific progress by offering inventors exclusive rights for a limited period as an incentive for their inventiveness and research efforts. U.S. Const., Art. I, § 8, cl. 8; *Diamond v. Chakrabarty*, 447 U.S. 303, 307 (1980). The Federal Circuit was created in 1982 to provide uniformity and predictability in the development and application of the patent laws and thereby to maintain the incentive for scientific innovation and research that the patent system was created to provide. S. Rep. No. 97-275, at 1-6 (1981), *reprinted in* 1982 U.S.C.C.A.N. 11, 11-16; The United States Court of Appeals for the Federal Circuit, *A History 1982-1990*, 1-14 (1991). The role of the Federal Circuit in the implementation of the patent laws is critical, as it has exclusive appellate jurisdiction over any case in which the complaint alleges a cause of action arising under them and, therefore, reviews most district court decisions regarding patent rights. 28 U.S.C. 1295(a); *Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826 (2002).

been criticized for its fact-finding and other forms of "hyperactive judging" on numerous occasions by commentators and district courts alike, particularly in the last few years. *See Control Resources, Inc. v. Delta Elecs., Inc.*, 133 F. Supp. 2d 121 (D. Mass. 2001); William C. Rooklidge & Mathew F. Weil, *Judicial Hyperactivity: The Federal Circuit's Discomfort With Its Appellate Role*, 15 Berkeley Tech. L.J. 725 (2000); Ted D. Lee & Michelle Evans, *The Charade: Trying a Patent Case to All "Three" Juries*, 8 Tex. Intell. Prop. L.J. 1 (1999); Douglas A. Strawbridge et al., *Patent Law Developments in the United States Court of Appeals for the Federal Circuit During 1986*, 36 Am. U. L. Rev. 861 (1987).

This Court recently reversed the Federal Circuit's expansive approach to its scope of judicial review of PTO patent decisions in *Dickinson v. Zurko*, 527 U.S. 150 (1999). This Court held that the standard the Federal Circuit had been applying was not sufficiently deferential to the PTO.

The *Zurko* case related to the issue of appeals brought by parties whose patent applications had been denied by the PTO. The case below presents this Court with the opportunity to review the Federal Circuit's expansive approach on two related and important matters: (1) whether and to what extent judicial deference is owed to the PTO's decisions when the validity of a patent issued by the PTO is subsequently challenged in litigation, and (2) under what circumstances the federal courts may grant summary judgment of invalidity, on substantially the same facts considered by the PTO.

A petition for *certiorari* is now pending before this Court in another patent infringement case in which the Federal Circuit has refused to give any deference to decisions of the PTO. This pending case arises in the context of whether judical deference is owed to the PTO's interpretation of its regulations regarding the issuance of patents. Even after *Zurko*, this pending case shows that the Federal Circuit has

still refused to give deference to the PTO's interpretation of its own regulations. *Dethmers Mfg. Co. v. Automatic Equipment Co.*, 293 F.3d 1364, 1365 (Dyk, J., concurring in part, dissenting in part), *reh'g en banc denied*, 293 F.3d 1364 (Fed. Cir. 2002) (Linn, J., dissenting), *petition for cert. filed*, 71 U.S.L.W. 3191 (Sept. 11, 2002) (No. 02-429).

The Federal Circuit's failure to follow traditional jurisprudence regarding the role of appellate courts vis-à-vis federal agencies and the Federal Rules in this case and others has prevented it from properly administering the patent laws. This failure resulted in a grave injustice to both the patentee and the patent system, whose strength and vitality depend as much upon the Federal Circuit's assumption of its proper role with regard to deference and the Federal Rules as it does upon the Federal Circuit's development of the substantive law, if not more. The Federal Circuit's failure to follow this Court's precedent in these areas has the pernicious effects of diminishing predictability in patent administration and adjudication, eroding the public's confidence in the value of patents generally, and undermining the incentive for scientific innovation for which the patent system was Constitutionally created.

## II. The Federal Circuit Erred in Giving No Deference to the United States Patent and Trademark Office's Patentability Decisions

Judicial review of PTO patent decisions may arise in two basic contexts: (1) when an applicant challenges the PTO's denial of a patent on direct judicial review; and (2) when a patent is the subject of infringement litigation and the accused infringer argues that the patent issued by the PTO is invalid. This case presents an important question, never addressed by this Court, of how much deference the federal courts should give to the PTO's patent decisions in the second context.

Just three years ago, this Court resolved the first issue in

*Dickinson v. Zurko*, 527 U.S. 150 (1999), by holding that the PTO's patentability decisions are findings of fact by an agency subject to the "arbitrary and capricious" and "substantial evidence" standards of review set forth in the Administrative Procedure Act, 5 U.S.C. § 706. The Federal Circuit in that case, as it did in the case below, had been applying a standard of review that gave less deference to the decisions of the PTO. In reversing the Federal Circuit, this Court held that the APA standards for judicial review apply regardless of whether the patent applicant seeks review directly at the Federal Circuit under 35 U.S.C. § 141 or in federal district court under 35 U.S.C. § 145. *Zurko*, 527 U.S. at 164. The Court also held that the standard applies to district court review even though section 145 "permits the disappointed applicant to present to the court evidence that the applicant did not present to the PTO." *Id.*[9]

Just one year ago, in *United States v. Mead Corp.*, 533 U.S. 218 (2001), this Court stated that almost all agency rulings were entitled to "some deference whatever its form, given the 'specialized experience and broader investigations and information' available to the agency, and given the value of uniformity in its administrative and judicial understandings of what a national law requires." *Id.* at 234.

Judicial deference to the PTO's patentability determinations would seem to be even more appropriate in light of the fact that the patent statute explicitly provides that a patent issued by the PTO "shall be presumed valid" and that "[t]he burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity." 35 U.S.C. § 282. This Court has stated that the burden of proof

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[9] Last year the Federal Circuit held that the APA standard of review adopted in *Zurko* has no application to a federal court's review of validity in a patent infringement action. *Purdue Pharma, L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1329 (Fed. Cir. 2000).

is clear and convincing evidence, *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 810 (1986), but has not addressed this specific issue of deference.

The opinion below presents a dramatic reason why this Court needs to resolve the related issue of how much deference is owed to PTO patent decisions in the context of patent infringement litigation. In the case below, the federal courts gave the PTO decisions absolutely no deference. In fact, they granted *summary judgment* to the alleged infringers and, entirely on factual issues, invalidated patents on inventions that the PTO decided on four occasions to be patentable on substantially the same evidence.

One could imagine a situation in which it is appropriate for courts to grant less deference to PTO decisions in the infringement context if, in that litigation, many new relevant facts were raised in the court that were not raised before the PTO in the patent application or reexamination process. But even in that circumstance, following the logic of *Zurko*, the demands of section 282, and the holding in *Mead*, one must at least start with the proposition that the patent in issue is presumed valid and that substantial deference is owed. One must logically assume that the burden would be on the defendant to demonstrate that new facts not considered by the PTO would in some material way demonstrate that the patent, entitled to a presumption of validity and substantial judicial deference, is nevertheless invalid.[10]

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[10] The Federal Circuit has stated that "the decision of the Patent and Trademark Office is accorded deference in district court litigation, deference that takes the form of the presumption of validity that is accorded to issued patents under 35 U.S.C. § 282." *Purdue Pharma*, 230 F.3d at 1329. Thus, the Federal Circuit does not appear to be of the view that the PTO's decision must be reviewed or considered, but only that the burden is on the party asserting invalidity to establish, on a *de novo* record, invalidity by clear and convincing evidence. *See also McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1353 (Fed. Cir. 2001).

The case for deference is even stronger in the present appeal where no new facts were raised in the district court. The case below presents a situation in which the relevant facts regarding the printed publications were in all material respects the same before both the PTO (at the patent application and reexamination stages) and the reviewing courts. By granting summary judgment on the issue of patent invalidity based on substantially the same facts, the courts below gave none of the deference owed to the PTO required by *Zurko*, section 282, and *Mead*.

As the great volume of patent infringement litigation in the federal courts shows no signs of abating, this case presents the Court with the opportunity to clarify the important question of the degree of judicial deference owed to the PTO in patent infringement litigation. As this Court's decisions and the statute unequivocally stand for the proposition that a substantial degree of deference is owed, and as the case below stands for the proposition that no deference is owed (even to the point of granting summary judgment to defendants), Petitioners submit that the decision below is incorrect as a matter of law and must be reversed. In correcting this mistake, the Court can provide much needed guidance to the federal courts on this important issue.

## III. The Federal Circuit Erred in Attacking the Nonmovant's Credibility and in Granting Summary Judgment Despite the Fact that the Movant Presented No Evidence on an Essential Element of Its Affirmative Defense

Under this Court's clear precedent, the Federal Circuit committed a double error—not only should it have reversed the district court's decision granting summary judgment in favor of Respondents, it should also have ordered that summary judgment be entered in favor of *Petitioners* on these facts. Respondents failed to present any evidence on an essential element of their affirmative defense—that the prior

publications relied upon described making cruciferous sprouts with the concentration of Phase 2 enzyme inducers required by the patent claims. Respondents' failure to do so entitled Petitioners to a grant of summary judgment in *their* favor under *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). In fact, Petitioners submitted substantial evidence that the concentrations of Phase 2 enzyme inducers required by the patent claims were *not* an inherent property of the subject matter described by the prior publications. The Federal Circuit's error also results from its failure to give deference to the fact that the PTO found the claims to be patentable based on essentially the same evidence and to follow the summary judgment standards set forth in *Anderson v. Liberty Lobby Inc.*, 477 U.S. 242 (1986).

### A. The Federal Circuit Decision Directly Conflicts with this Court's Holding in *Celotex Corp. v. Catrett*

In *Celotex*, this Court held that Rule 56(c) of the Federal Rules of Civil Procedure mandates the entry of summary judgment against a party who

> fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. In such a situation, there can be 'no genuine issue of material fact,' since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial.

477 U.S. at 322-23. The burden on the moving party is discharged by "'showing'—that is, pointing out to the district court—that there is an absence of evidence to support the nonmoving party's case." *Id.* at 325. This Court has reiterated this standard on several occasions in a variety of legal claims. *See Cleveland v. Policy Mgmt. Sys. Corp.*, 526 U.S. 795 (1999); *Hunt v. Cromartie*, 526 U.S. 541 (1999), *Lujan*

*v. National Wildlife Federation*, 497 U.S. 871 (1990). Although this Court has never addressed the standard for summary judgment when patent validity is being litigated, there can be no real dispute that the *Celotex* standard should apply to a defense of patent invalidity as well.

Respondents failed to submit *any* evidence that the prior publications relied upon in their motion for summary judgment disclosed all of the elements of the inventions claimed in the patents. More specifically, Respondents did not submit any evidence that any of the publications disclosed making cruciferous sprouts with the concentrations of Phase 2 enzyme inducers required by the patent claims. That is, they never submitted any evidence either that the requisite high concentrations, or at least 200,000 units per gram fresh weight sprouts, of Phase 2 enzyme inducers were an inherent property of the cruciferous sprouts described in the publications. Therefore, Respondents completely failed to establish the existence of an element essential to their affirmative defense on which they bore the burden of proof by clear and convincing evidence. Accordingly, Respondents' motion for summary judgment should have been denied.

The lower courts' failure to deny Respondents' summary judgment is even more egregious in light of section 282 and the clear law requiring deference to agency determinations. The Petitioners submitted, both at the PTO and at the district court, substantial evidence that the concentrations of Phase 2 enzyme inducers required by the patent claims were *not* an inherent property of the subject matter described by the prior publications. Petitioners submitted a sworn declaration stating that concentrations of Phase 2 enzyme inducers among cultivars of cruciferous sprouts varied widely, and that many cruciferous sprout cultivars did not have the requisite concentrations of Phase 2 enzyme inducers required by the patent claims. App. L, ¶¶ 7-10, at pp. 44a-45a.

Under this Court's clear precedents, the Federal Circuit

should have reversed the district court's decision and ordered that summary judgment be entered in favor of *Petitioners* on these facts. The PTO's decisions were entitled to substantial deference. Respondents failed to present evidence on an essential element of their case—that the prior publications relied upon described making cruciferous sprouts with the concentration of Phase 2 enzyme inducers required by the patent claims. Respondents' failure to do so meant there were no disputed facts for the jury to decide with respect to that essential element. *Celotex*, 477 U.S. at 322-23, *Anderson*; 477 U.S. at 250. The absence of a genuine issue of material fact on this essential element of Respondents' affirmative defense entitled Petitioners to a grant of summary judgment in *their* favor.

### B. The Federal Circuit Decision Directly Conflicts with *Anderson v. Liberty Lobby, Inc.*

The Federal Circuit's error in granting summary judgment to Respondents also stems from its obvious failure to follow the standards set forth in *Anderson v. Liberty Lobby, Inc.*. In *Anderson*, this Court clearly stated that at the summary judgment stage:

> (a) "the judge's function is not himself to weigh the evidence and determine the truth of the matter but to determine whether there is a genuine issue for trial";
>
> (b) "[c]redibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of the judge"; and
>
> (c) "[t]he evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor".

477 U.S. at 249, 255.[11]

Although the Federal Circuit paid lip service to these rules, its actions speak louder. First, as previously discussed, it appears that the Federal Circuit never reviewed the parties' evidence on the inherency issue because Respondents never submitted any evidence that either the requisite high concentrations, or at least 200,000 units per gram fresh weight sprouts, of Phase 2 enzyme inducers were an inherent property of the cruciferous sprouts described in the prior publications, whereas Petitioners submitted evidence that this property was *not* inherent in that subject matter. *See Anderson*, 477 U.S. at 248 ("[T]he substantive law will identify which facts are material."). Further, because there was no evidence in the record from which the Federal Circuit could infer that the subject matter disclosed in the prior publications inherently possessed all of the patent claim elements to support a finding of inherency, the inference that the Federal Circuit drew was also unjustified.

Second, in granting summary judgment, the Federal Circuit found facts and made credibility determinations against the nonmovant, which were expressly admonished in *Anderson*.[12] The Federal Circuit's determination that "Brassica cannot *credibly* maintain that no one has heretofore grown and eaten one of the many suitable cultivars identified by its patents" was plainly improper on summary judgment.

Lastly, the Federal Circuit's credibility determination regarding prior use (*i.e.*, that one of the suitable cultivars must have previously been eaten) was also misplaced and without basis because a prior public use defense was neither

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[11] *See also Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 150-51 (2000); *Hunt*, 526 U.S. at 551-53; *Crawford-El v. Britton*, 523 U.S. 574, 600 (1998).

[12] *See also Reeves*, *Hunt*; and *Crawford-El*, *supra*, note 11.

advanced by Respondents nor addressed by Petitioners. Respondents' invalidity defense was based on prior publication, not prior public use. Prior printed publication and prior public use are separate and distinct statutory bases for invalidity. 35 U.S.C. § 102(b) (A person shall be entitled to a patent unless ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States...."). The Federal Circuit confused the two legal theories. In any case, summary judgment based on prior public use in this country could not have been granted in Respondents' favor because they never presented evidence of an invalidating use. *See Finnigan Corp. v. ITC*, 180 F.3d 1354, 1367 (Fed. Cir. 1999).

## CONCLUSION

For the foregoing reasons, Petitioners respectfully request that the Court issue a writ of certiorari to review the judgment of the Court of Appeals for the Federal Circuit.

Respectfully submitted,

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